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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/500,483	06/29/2004	Ulrich Bohne	3012	4388
7590	06/28/2006		EXAMINER	
Striker Striker & Stenby 103 East Neck Road Huntington, NY 11743			HAMILTON, ISAAC N	
			ART UNIT	PAPER NUMBER
			3724	

DATE MAILED: 06/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/500,483	BOHNE ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	Isaac N. Hamilton	3724

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 18 April 2006.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) 5,6,10 and 11 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-4,7-9 and 12-15 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 29 June 2004 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____.
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>06/29/04, 06/13/05</u> .	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____.

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election with traverse of Species II, claims 1-4, 7-9 and 12-15, in the reply filed on 04/18/06 is acknowledged. The traversal is on the ground(s) that the present application is a US national phase application based on the PCT application. This is not found persuasive because species requirements are allowed in US national phase applications based on the PCT application, which states that if claims are directed to more than one species of the generic invention, then the species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

Further, applicant is required, in reply to a lack of unity of invention, to elect a single species to which the claims shall be restricted if no generic claim is finally held to be allowable. The reply must also identify the claims readable on the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Additionally, upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species.

MPEP § 809.02(a).

Initially, the Examiner did not recognize that the instant application was filed under 35 USC 371, however, applicant has elected species II and has modified the claim limitations with

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amendments, and therefore, the species election stands and claims 5, 6, 10 and 11 are withdrawn from further consideration unless there is an allowable generic or linking claim.

***Drawings***

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the “connection stub” in claim 9, line 3, must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Specification***

3. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed

150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

4. The abstract of the disclosure is objected to because it is two paragraphs. "(Fig. 2b)" should be deleted from the abstract. Correction is required. See MPEP § 608.01(b).

5. The disclosure is objected to because of the following informalities: page 6, line 2, "1a" should be changed to -1—because Figure 1 is the correct number of the figure that is being referred to in the description; page 6, line 4, "1b" should be changed to -1a-- because Figure 1a is the correct number of the figure that is being referred to in the description; page 6, line 6, "1c" should be changed to -1b-- because Figure 1b is the correct number of the figure that is being referred to in the description; page 7, lines 4-5, "Figs. 1a through 1c" should be changed to - Figs. 1 through 1b--.

Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1-4, 7-9 and 12-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 1, the phrase "in particular" renders the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1-4, 7-9 and 12-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Campbell et al (6,219,922), hereafter Campbell '922. Campbell '922 discloses circular saw 14; covering 12, 50; adjustable residue guide 10; outlet opening 26; carries dust in a defined direction as shown in figure 1; one position shown in figures 1 and 2; the saw blade of circular saw 14 intrinsically carries some of the machining residues onward inside covering 12, and at least some of the dust is carried through residue guide 10 and discharged into covering 50; pivot tube 24; pivot axis is collinear with element 16; one position in figure 1 wherein in one position the pivot tube 24 discharges into covering 50; positions in figure 2 wherein pivot tube 24 discharges out of covering 12 into the air surrounding circular saw 14; feed tube 16; rotary slide 28; guide tube 22; connection stub juxtaposed element 26 and the bend in element 22; the connection stub is capable of being attached to a suction or vacuum source; residue guide 10 is adjustable continuously along element 28; detent means 30; detent position shown in figure 2; spring element 18; defined positions in figure 2; apparatus 14; covering 12, 50; residue guide 10.

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10. Claims 1, 7, 9 and 12-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Campbell (6,094,827), hereafter Campbell '827. Campbell '827 discloses circular saw 10; covering 16; adjustable residue guide 30; outlet opening 28; when residue guide 30 is in the closed position as shown in figure 5 at least some of the machining residue are carried onward inside covering 16; rotary slide 32; connection stub adjacent element 34; element 34 is capable of being removed and a suction or vacuum source can be attached to the area adjacent element 34 on rotary slide 32; residue guide 30 is adjustable continuously as it rotates about element 36; detent means 82; detent position shown in figures 3 and 4; spring element 44; defined position in figure 5; apparatus 10; covering 16; residue guide 30.

11. Claims 1-3, 7-9, 12 and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Sasaki et al (5,927,171), hereafter Sasaki. Sasaki discloses circular saw 10; covering 9, 12; adjustable residue guide 17, 21, 16, 15, 14; outlet opening 16; carries dust in a defined direction as shown in figure 6; one position wherein the residue guide carries some of the machining residues onward inside covering is recited in column 3, lines 51-54; position wherein dust is carried through residue guide 10 and discharged outside the covering is recited in column 3, lines 54-65; pivot tube 17, 21; pivot axis 24; rotary slide 22; guide tube 16; connection stub 16; the connection stub is capable of being attached to a suction or vacuum source; residue guide is adjustable continuously as shown in figure 8; apparatus 1; covering 9, 12; residue guide 17, 21, 16, 15, 14.

***Conclusion***

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The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Campbell et al (6,502,316), Olson, Mayo and Doumani et al are cited for similar structure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Isaac Hamilton whose telephone number is 571-272-4509. The examiner can normally be reached on Monday through Friday between 8am and 5pm.

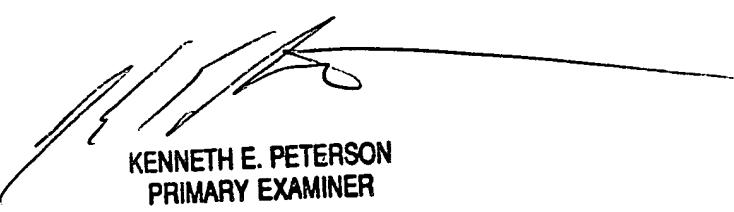
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Boyer D. Ashley can be reached on 571-272-4502. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



IH

June 20, 2006



KENNETH E. PETERSON  
PRIMARY EXAMINER